REMARKS

Reconsideration and allowance are respectfully requested. Before entry of this response, claims 1-17 were pending. In the Office Action, claims 1-17 were rejected. In the present response, claims 1-17 are amended, and claims 18-19 are added. After entry of this amendment, claims 1-19 are pending.

I. Non-statutory obviousness-type double patenting

The Examiner has provisionally rejected claims 1-17 on the ground of nonstatutory, obviousness-type double patenting over claims 1-20 of copending Application No. 10/761,883, claims 1-15 of copending Application No. 10/761,864, and claims 1-24 of copending Application No. 10/972,765. Applicants consider the current claims 1-17 of this application to be patentably distinct from the current versions of the claims in the referenced related applications. However, all of the cited applications are currently pending, making it difficult to address the merits of the rejection with certainty.

In the event that all remaining rejections to the claims of the instant application are withdrawn and the claims of copending applications nos. 10/761,883, 10/761,864, and 10/972,765 are still pending, Applicants will either submit a terminal disclaimer of the instant patent application over copending application nos. 10/761,883, 10/761,864, and 10/972,765 or address the merits of the rejection directly.

II. Claim Objections

The Examiner is thanked for his careful reading of the claims. The informality of claim 1 objected to by the Examiner in the Office Action (Office Action, p. 3, lines 4-6) has been corrected in the amended claim 1. Furthermore, all of the claims have been reviewed for typographical and grammatical errors.

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III. Claim Rejections – 35 U.S.C. § 112

A. Dependent Claims 2-15

The Examiner correctly notes the insufficient antecedent basis for the limitation "unsolicited message blocking" recited in the first line of claims 2-15. Claims 2-15 have been amended to replace this limitation with the limitation "unsolicited message rejecting" that is supported by claim 1, upon which claims 2-15 depend.

B. Independent Claim 1

The Examiner points out several instances of vagueness and/or ambiguity in the language of claim 1 (Office Action p. 3, line 19 – p. 4, line 11). Applicants have amended claim 1 to address these concerns.

C. Dependent Claim 11

The Examiner correctly notes the inconsistent use of the term "actual domain of DD_0" in claim 1 and the use of the term "the real domain DD_1" in claim 11, which depends from claim 1. This inconsistency has been corrected. Claim 1 has been amended to recite, "a real domain DD_0", and claim 11 has been amended to recite "the real domain DD_0".

III. Claim Rejections – 35 U.S.C. § 102(e)

A. Claims 1-7, 9, 11-13 and 16

Claims 1-7, 9, 11-13 and 16 are rejected under 35 U.S.C. § 102(e) as being anticipated by Donaldson (US 7,249,175). (Office Action, p. 5, lines 11-12)

1. Independent Claim 1

Claim 1 as amended recites:

> "wherein the unsolicited message rejecting
> communications processor does not intercept
> communications between MTA_0 and MTA_1 before
> a .\r\n end-of-message indicator reply from MTA_0 is

received by the unsolicited message rejecting communications processor."

Donaldson does not form the basis for a valid rejection of claim 1 under 35 U.S.C. § 102(e) because Donaldson does not disclose "wherein the unsolicited message rejecting communications processor <u>does not intercept communications between MTA_0 and MTA_1 before a .\r\n end-of-message indicator reply from MTA_0 is received</u> by the unsolicited message rejecting communications processor" (emphasis added).

The passage of Donaldson cited by the Examiner (Donaldson, col. 40, lines 21-39) discloses that "the proxy proceeds to transfer the RCPT message to the MTA, beginning at step 1637" (Donaldson, col. 40, lines 32-34). This transfer of the RCPT message <u>does not disclose</u> "<u>does not intercept communications between MTA_0 and MTA_1 before a .\r\n end-of-message indicator reply</u> from MTA_0 is received" (emphasis added). The RCPT message is only one of many SMTP messages that are exchanged between MTA_0 and MTA_1 before the .\r\n end-of-message indicator reply is made (see Donaldson, Fig. 2); far short of "<u>does not intercept communications</u>."

The Donaldson reference makes many disclosures contrary to the recited language of Claim 1. For instance, Donaldson explains that the Donaldson Active Filtering Proxy interacts with "MTA_0", performs tests, and in some circumstances, closes the connection before any connection is made to the "MTA_1". (Donaldson, col. 12, lines 11-19). Donaldson discloses that "Because the proxy 1401 controls when it reads data on the connection 1403, it is not possible for the remote host 1400 to proceed with transfer of its message until the proxy 1401 completes its filtering." These scenarios <u>do not disclose</u> "<u>does not intercept communications between MTA_0 and MTA_1 before a .\r\n end-of-message indicator reply</u> from MTA_0 is received." Donaldson suggests doing testing as early as possible. Donaldson always takes control of the connection immediately upon establishment of the TCP/IP connection between the "MTA_0" and the "communications processor". Claim 1 on the other hand, recites that the

unsolicited message rejecting communications processor <u>does not intercept communications between MTA_0 and MTA_1 before a .\r\n end-of-message indicator reply</u> from MTA_0 is received" (emphasis added).

Because Donaldson does not disclose the recited limitation "wherein the unsolicited message rejecting communications processor <u>does not intercept communications between MTA_0 and MTA_1 before a .\r\n end-of-message indicator reply from MTA_0 is received</u> by the unsolicited message rejecting communications processor", reconsideration of the § 102(e) rejection and allowance of claim 1 is requested.

2. Dependent Claims 2-5, 7, 9 and 11

Claims 2-5, 7, 9 and 11 depend from claim 1 and include the following limitation from claim 1: "wherein the unsolicited message rejecting communications processor <u>does not intercept communications between MTA_0 and MTA_1 before a .\r\n end-of-message indicator reply from MTA_0 is received</u> by the unsolicited message rejecting communications processor" (emphasis added).

As explained above with regard to claim 1, Donaldson does not teach the recited limitation on the unsolicited message rejecting communications processor "<u>does not intercept communications between MTA_0 and MTA_1 before a .\r\n end-of-message indicator reply from MTA_0 is received</u>". For at least the same reasons for which claim 1 is allowable, claims 2-5, 7, 9 and 11 are allowable. Reconsideration of the § 102(e) rejection and allowance of claims 2-5, 7, 9 and 11 are requested.

3. Dependent Claim 6

Claim 6 depends from claim 1 and is allowable for at least the same reasons for which claim 1 is allowable. Reconsideration of the § 102(e) rejection and allowance of claim 6 is requested.

Furthermore, claim 6 as amended recites:

"The unsolicited <u>message rejecting</u> communications processor in Claim 1, further includes a bad_from database and wherein the determining means determines if the message is unsolicited by checking if the from-address A_0 is in the bad_from database."

Donaldson does not form the basis for a valid rejection of claim 6 under 35 U.S.C. § 102(e) because Donaldson does not disclose "further includes a bad_from database and wherein the determining means determines if the message is unsolicited by <u>checking if the from-address A 0 is in the bad from database</u>" (emphasis added).

The passage of Donaldson cited by the Examiner (Donaldson, col. 11, line 58 – col. 12, line 10) discloses a "Blacklist DB [database] 1095, which <u>identifies IP addresses</u> of remote hosts that will be blocked immediately after they connect to the proxy server" (bracketed text added and emphasis added) (Donaldson, col. 11, lines 62-64). The Donaldson Blacklist database is <u>not a list of named addresses listed in the "bad from database"</u>. Another passage of Donaldson cited by the Examiner (Donaldson, col. 43, lines 7-39) discloses "per-recipient whitelisting" where "a message can be directly transferred to one set of recipients and simultaneously rejected or quarantined for the remaining recipients" (Donaldson, col. 43, lines 13-16). Donaldson discloses that "because of per-recipient whitelisting" a message that fails Active Filtering <u>is not rejected</u> for all recipients. Rather, <u>messages from senders on the per-recipient whitelist may be sent through</u>. (Donaldson, col. 43, lines 13-25). The Donaldson per-recipient whitelist is not a list of named addresses listed in the "bad_from database", "wherein the determining means determines if the message is <u>unsolicited</u> by checking if the from-address A_0 is in the bad_from database" (emphasis added).

In addition to its dependence on allowable claim 1, claim 6 is also allowable because Donaldson does not disclose "a bad_from database and wherein the determining means determines if [[a]]the message is unsolicited by

checking if the <u>from-address A_0 is in the bad_from database</u>." Reconsideration of the § 102(e) rejection and allowance of claim 6 is requested.

4. Dependent Claim 12

Claim 12 depends from claim 1 and is allowable for at least the same reasons for which claim 1 is allowable. Reconsideration of the § 102(e) rejection and allowance of claim 12 is requested.

Furthermore, claim 12 as amended recites:

> "The unsolicited message rejecting communications processor in Claim 1, further includes a bad_word database and wherein the determining means determines if the message is unsolicited by checking if the <u>subject line</u> of the message <u>contains any words in the bad_word database</u>" (emphasis added).

Donaldson does not form the basis for a valid rejection of claim 12 under 35 U.S.C. § 102(e) because Donaldson does not disclose "wherein the determining means determines if the message is unsolicited by checking if the <u>subject line</u> of the message contains any words in the bad_word database" (emphasis added).

The passage of Donaldson cited by the Examiner states "a check for . . . content match . . . The content match <u>checks for keywords in the MAIL From address</u>" (Donaldson, col. 46, lines 26-29). The content check disclosed by Donaldson includes a check for content in the MAIL From address and does not disclose "checking if the <u>subject line</u> of the message <u>contains any words in the bad_word database</u>."

Because Donaldson does not disclose "checking if the subject line of the message contains any words in the bad_word database," reconsideration of the § 102(e) rejection and allowance of claim 12 are requested.

5. Dependent Claim 13

Claim 13 depends from claim 1 and is allowable for at least the same

reasons for which claim 1 is allowable. Reconsideration of the § 102(e) rejection and allowance of claim 13 is requested.

Furthermore, claim 13 as amended recites:

> "The unsolicited message rejecting communications processor in Claim 1, further includes a bad_fingerprint database and wherein the determining means determines if the hash "fingerprint" of a portion of the <u>body of the message</u> is in the bad_fingerprint database.

Donaldson does not form the basis for a valid rejection of claim 13 under 35 U.S.C. § 102(e) because Donaldson does not disclose "a bad_fingerprint database and wherein the determining means determines if the hash "fingerprint" of a portion of the <u>body of the message</u> is in the bad_fingerprint database (emphasis added).

The passage of Donaldson cited by the Examiner states "a check for . . . content match . . . The content match checks for keywords <u>in the MAIL From address</u>" (Donaldson, col. 46, lines 26-29). The content check disclosed by Donaldson does not disclose checking if "a portion of the <u>body of the message</u> is in the bad_fingerprint database" (emphasis added). The cited passage of Donaldson (col. 45, lines 12-51) does not disclose checking the body of the message for anything.

Because Donaldson does not disclose "determines if the hash "fingerprint" of a portion of the <u>body of the message</u> is in the bad_fingerprint database," reconsideration of the § 102(e) rejection and allowance of claim 13 are requested.

6. <u>Independent Claim 16</u>

Claim 16 as amended recites:

> "comprising the steps of:
> a) waiting for a new SMTP connection request;
> b) relaying and monitoring the replies from MTA_0 to MTA_1;

c) relaying replies from MTA_1 to MTA_0;
d) intercepting the .\r\n end-of-message indicator reply from MTA_0 to MTA_1;
e) determining if the message is unsolicited by analyzing the monitored replies;
f) releasing the intercepted .\r\n end-of-message reply if the message is determined not to be unsolicited; and
g) sending [[a]]an error reply to MTA_0 to force MTA_0 and MTA_1 to close down their connection; whereby MTA_1 controls the interaction between MTA_0 and MTA_1 until a .\r\n end-of-message indicator reply is received from MTA_0."

Donaldson does not form the basis for a valid rejection of claim 16 under 35 U.S.C. § 102(e) because Donaldson does not disclose "intercepting the .\r\n end-of-message indicator reply from MTA_0 to MTA_1; determining if the message is unsolicited by analyzing the monitored replies; releasing the intercepted .\r\n end-of-message reply if the message is determined not to be unsolicited; and sending an error reply to MTA_0 to force MTA_0 and MTA_1 to close down their connection; whereby MTA_1 controls the interaction between MTA_0 and MTA_1 until a .\r\n end-of-message indicator reply is received from MTA_0" (emphasis added).

The passage of Donaldson cited by the Examiner (Donaldson, col. 34, lines 3-5) discloses that the proxy 1401 awaits "MTA_1's" response from the MAIL From message, and writes that response immediately to "MTA_0". The MAIL From message is not the .\r\n end-of-message indicator and awaiting the response from MTA_1 and writing that response to MTA_0 is not "intercepting the .\r\n end-of-message indicator reply from MTA_0 to MTA_1". First, Donaldson is relaying as opposed to intercepting. Second, Donaldson is relaying a MAIL From message, not a .\r\n end-of-message indicator. Third, the communication being relayed in Donaldson is in the direction opposite the claimed interception.

During the data transfer of a message, Donaldson discloses that "the proxy compares each line of text with the SMTP end-of-message indicator. . . and if the current line indicates the end of message, the proxy closes the quarantine file . . . " (Donaldson, col. 44, lines 6-14). Donaldson discloses using the end-of-message indicator to trigger closing a quarantine file, but this is done after the decision to quarantine has already been made. The claimed steps of "intercepting the .\r\n end-of-message indicator reply from MTA_0 to MTA_1" and then "determining if the message is unsolicited by analyzing the monitored replies" uses the end-of-message indicator to trigger testing and enforcement of e-mail filtering decisions. Donaldson discloses the opposite procedure in which "determining if the message is unsolicited" has already occurred by the time of "the .\r\n end-of-message indicator reply from MTA_0 to MTA_1."

A passage of Donaldson cited by the Examiner states, "when a remote host 1400 establishes a TCP connection 1403 to the proxy . . . the proxy server 1401 gets the IP address of the remote host and compares the IP address with a database of disallowed addresses. If the IP address of the remote host 1400 matches an entry in the database, the proxy server closes the TCP connection 1403 without transferring an email message" (Donaldson col. 15, lines 51-58). It is clear that upon connection with "MTA_0", Donaldson engages in immediate testing and possible rejection of the connection. The method disclosed in Donaldson is completely contrary to "a) waiting for a new SMTP connection request; b) relaying and monitoring the replies from MTA_0 to MTA_1; c) relaying replies from MTA_1 to MTA_0; d) intercepting the .\r\n end-of-message indicator reply from MTA_0 to MTA_1;" and then "e) determining if the message is unsolicited by analyzing the monitored replies."

The Examiner points to the passage of Donaldson that states, "releasing the intercepted .\r\n end-of-message reply if the message is determined not to be unsolicited" (Office Action, p. 9, lines 1-3). However, Donaldson discusses the .\r\n indicator is only with regard to quarantine files and using the .\r\n indicator to trigger the closing of the quarantine file. (Donaldson, col. 44, lines 3-16).

Donaldson uses the .\r\n indicator to trigger the closing of a quarantined message file after the quarantine decision has already been made. Donaldson does not disclose "releasing the intercepted .\r\n end-of-message reply if the message is determined not to be unsolicited." Moreover, the other passages of Donaldson cited by the Examiner (Donaldson, col. 20, lines 6-23 and col. 40, lines 29-34) deal with proxy decisions made at MAIL From message time rather than .\r\n time.

Finally, the Examiner states that Donaldson discloses "sending a error reply to MTA_0 to force MTA_0 and MTA_1 to close down their connection; whereby MTA_1 controls the interaction between MTA_0 and MTA_1 until a .\r\n end-of-message indicator reply is received from MTA_0". (Office Action, p. 9, lines 3-7). As discussed above, the passages from Donaldson cited by the Examiner do not discuss steps occurring at .\r\n time (Donaldson, col. 40, lines 29-34 and col. 20, lines 6-23) or do not involve the use of the .\r\n indicator to trigger the closing of a quarantine file (Donaldson, col. 44, lines 3-16). Donaldson does not disclose MTA_1 to control "the interaction between MTA_0 and MTA_1 until a .\r\n end-of-message indicator reply is received from MTA_0".

Donaldson includes several teachings that are contrary to the recited language of Claim 16. For instance, Donaldson explains that the Donaldson Active Filtering Proxy interacts with "MTA_0", performs tests, and in some circumstances, closes the connection before any connection is made to the "MTA_1". (Donaldson, col. 12, lines 11-19). Donaldson discloses that "Because the proxy 1401 controls when it reads data on the connection 1403, it is not possible for the remote host 1400 to proceed with transfer of its message until the proxy 1401 completes its filtering." These scenarios do not disclose allowing MTA_1 to control " the interaction between MTA_0 and MTA_1 until a .\r\n end-of-message indicator reply is received from MTA_0." Donaldson suggests doing testing as early as possible. Donaldson always takes control of the connection immediately upon establishment of the TCP/IP connection between the "MTA_0" and the "communications processor". Claim 16 on the other hand, recites

"whereby MTA_1 controls the interaction between MTA_0 and MTA_1 until a .\r\n end-of-message indicator reply is received from MTA_0."

Because Donaldson does not disclose the recited method steps of claim 16 and the recited limitation "whereby MTA_1 controls the interaction between MTA_0 and MTA_1 until a .\r\n end-of-message indicator reply is received from MTA_0", reconsideration of the § 102(e) rejection and allowance of claim 16 is requested.

IV. Claim Rejections - 35 U.S.C. § 103(a)

A. Claims 8 and 10

Claims 8 and 10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Donaldson in view of Levosky (US 2002/0087641) and further in view of Wilson (2004/0015554) (Office Action, p. 9, lines 10-11). Claims 8 and 10 depend from claim 1 and includes the following limitation from claim 1: "wherein the unsolicited message rejecting communications processor does not intercept communications between MTA_0 and MTA_1 before a .\r\n end-of-message indicator reply from MTA_0 is received by the unsolicited message rejecting communications processor" (emphasis added).

The combination of Donaldson, Levosky and Wilson does not form the basis for a valid rejection of claims 8 and 10 under § 103(a) because none of the references teach "does not intercept communications between MTA_0 and MTA_1 before a .\r\n end-of-message indicator reply from MTA_0 is received." As explained above with regard to base claim 1, Donaldson does not teach "does not intercept communications between MTA_0 and MTA_1 before a .\r\n end-of-message indicator reply from MTA_0 is received." Moreover, neither Wilson or Levosky teaches "does not intercept communications between MTA_0 and MTA_1 before a .\r\n end-of-message indicator reply from MTA_0 is received."

Because the combination of Donaldson, Levosky and Wilson does not teach the recited limitations of Claims 8 and 10 derived from their dependence on

claim 1, reconsideration of the § 103(a) rejection and allowance of claims 8 and 10 is requested.

B. Claim 14

Claim 14 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Donaldson in view of Levosky (US 2002/0087641) (Office Action, p. 10, lines 9-10). Claim 14 depends from claim 1 and includes the following limitation from claim 1: "wherein the unsolicited message rejecting communications processor does not intercept communications between MTA_0 and MTA_1 before a .\r\n end-of-message indicator reply from MTA_0 is received by the unsolicited message rejecting communications processor" (emphasis added).

The combination of Donaldson and Levosky does not form the basis for a valid rejection under § 103(a) because neither of the references teaches "does not intercept communications between MTA_0 and MTA_1 before a .\r\n end-of-message indicator reply from MTA_0 is received." As explained above with regard to base claim 1, Donaldson does not teach "does not intercept communications between MTA_0 and MTA_1 before a .\r\n end-of-message indicator reply from MTA_0 is received." Moreover, Levosky does not teach "does not intercept communications between MTA_0 and MTA_1 before a .\r\n end-of-message indicator reply from MTA_0 is received."

Because combination of Donaldson and Levosky does not teach the recited limitation of Claim 14 derived from its dependence on claim 1, reconsideration of the § 103(a) rejection and allowance of claims 14 are requested.

Furthermore, claim 14 as amended recites, "a rejected_connection database which logs the time, from-address A_0, to-address A_1, and the reason for the rejection if the message is determined to be unsolicited." The combination of Donaldson and Levosky does not form the basis for a valid rejection of claim 14 under § 103(a) because neither Donaldson or Levosky

teaches logging the time, from_address A_0, to address A_1, and the reason for the rejection if the message is determined to be unsolicited.

The Examiner acknowledges that Donaldson does not teach the limitations of claim 14 (Office Action p. 10, lines 11-15). In the Office Action, the Examiner relies on Levosky as teaching the missing claim limitations. But Levosky also does not teach logging the time, from_address A_0, to address A_1, and the reason for the rejection if the message is determined to be unsolicited. Levosky teaches logging the history of messages received by a particular address and the user's decision to possibly block or suspend the forwarding of these messages (Levosky, [0065]). Levosky does not teach logging "the reason for the rejection if the message is determined to be unsolicited." Levosky logs the status of the message, but the reasoning for that status is determined by the user, rather than the "communications processor". For this reason, Levosky fails to teach "a rejected_connection database which logs the time, from-address A_0, to-address A_1, and the reason for the rejection if the message is determined to be unsolicited."

Finally, the Examiner's argument fails to satisfy the standard for obviousness enunciated in *KSR v. Teleflex*. In order to find that a claim is obvious, there must be "an apparent reason to combine the known elements in the way a patent claims . . .." *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 82 USPQ2d 1385 (2007) (emphasis added). The Examiner's rationale for combining Donaldson and Levosky is "to have incorporated the known technique of using logs as taught by Levosky into the known system of Donaldson for the predictable result of enabling the storage of a record of past transactions." (Office Action, p. 11, lines 1-3). This rationale provides no apparent reason why a person of ordinary skill in the art would have designed a log in the way of claim 14. A motivation to enable storage of a record of past transactions is not an apparent reason to append the Active Filter of Donaldson with a log file of Levosky in any particular way, such as the way claimed. Neither Donaldson or Levosky teaches logging the reason for the rejection if the message is

determined to be unsolicited in the way claimed. Moreover, storing records of past transactions is not an apparent reason to log the reason why an unsolicited message was rejected.

Because the combination of Donaldson and Levosky does not teach a rejected_connection database that logs the time, from-address A_0, to-address A_1, as well as the reason for the rejection if the message is determined to be unsolicited, reconsideration of the § 103(a) rejection and allowance of claim 14 is requested.

C. Claim 15

Claim 15 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Donaldson in view of Levosky (US 2002/0087641) (Office Action, p. 10, lines 9-10). Claim 15 depends from claim 1 and includes the following limitation from claim 1: "wherein the unsolicited message rejecting communications processor <u>does not intercept communications between MTA_0 and MTA_1 before a .\r\n end-of-message indicator reply from MTA_0 is received</u> by the unsolicited message rejecting communications processor" (emphasis added).

The combination of Donaldson and Levosky does not form the basis for a valid rejection under § 103(a) because neither of the references teaches "does not intercept communications between MTA_0 and MTA_1 before a .\r\n end-of-message indicator reply from MTA_0 is received." As explained above with regard to base claim 1, Donaldson does not teach "does not intercept communications between MTA_0 and MTA_1 before a .\r\n end-of-message indicator reply from MTA_0 is received." Moreover, Levosky does not teach "does not intercept communications between MTA_0 and MTA_1 before a .\r\n end-of-message indicator reply from MTA_0 is received." Consequently, no hypothetical combination or permutation of Donaldson and Levosky would include "does not intercept communications between MTA_0 and MTA_1 before a .\r\n end-of-message indicator reply from MTA_0 is received".

Because Donaldson in combination with Levosky does not teach the recited limitation of Claim 15 derived from its dependence on claim 1, reconsideration of the § 103(a) rejection and allowance of claims 15 is requested.
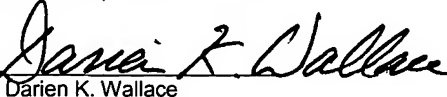
V. Claims 18-19

Applicants are adding new claims 18-19 to further clarify and distinguish the subject matter that Applicants regard as their invention. Each new claim is supported by the specification and is allowable over the cited references.

VI. Conclusion

In view of the foregoing remarks, Applicants respectfully submit that the entire application (claims 1-19 are pending) is in condition for allowance. Applicants respectfully request that a timely Notice of Allowance be issued in this case. If the Examiner would like to discuss any aspect of this application, the Examiner is requested to contact the undersigned at (925) 550-5067.

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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